

## **REMARKS**

### **I. Status of Claims**

Claims 1-3, 5-7, 9-13, and 15-17, and 19-20 are pending in the application. Claims 1 and 11 are the independent claims, with claim 1 being the elected independent claim. Claims 4, 8, and 14 were previously canceled without prejudice to and/or disclaimer of the subject matter therein. Claims 11-13, 15-17, and 19-20 are withdrawn from consideration. Thus, claims 1-3, 5-7, and 9-10 are the elected claims under consideration.

Claims 1, 3, and 5 stand rejected under 35 USC 102(b) as allegedly being anticipated by Fariello (USP 1,858,144) (“Fariello”).

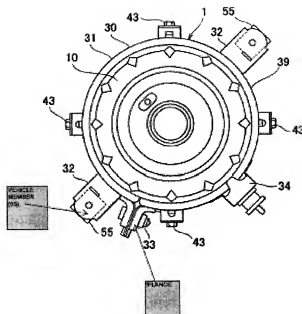
Claims 1, 3, 5-7, and 10-11 stand rejected under 35 USC 103(a) as allegedly being unpatentable over Guenther (USP 1,226,968) (“Guenther”) in view of case law.

The Applicant respectfully requests reconsideration of these rejections in view of the foregoing amendments to the specification and the following remarks.

### **II. Drawings**

The Office Action objects to the drawings under 37 CFR 1.83(a) because allegedly 1) the receiving member is not shown in the drawings; 2) the flange formed on both ends of the band (paragraph [0019] of Applicant’s specification as filed) is not shown in the drawings; and 3) because reference characters “21” and “31” have been both used to designate the band in paragraph [0019] of the Applicant’s specification as filed (which equates to paragraph [0030] of the application as published).

As an initial matter, it is respectfully submitted that the vehicle member, for example, element 55, is shown in annotated FIG. 4 provided herein below. Also, it is respectfully submitted that the flange of band 31 is also shown in at least FIG. 4. Accordingly, based on the elements shown in FIG. 4, the Applicant respectfully requests withdrawal of these objections.



With respect to the objection of paragraph [0019]/[0030] of the Applicant's specification as-filed/specification as published, it is respectfully submitted that the foregoing amendments to the specification should obviate any perceived ambiguity, thus, withdrawal of this objection is respectfully requested.

### **III. Pending Claims and 35 USC § 102/103 Rejections**

Independent claim 1, the only independent claim under consideration, stands rejected under 35 USC 102(b) as allegedly being anticipated by Fariello and under 35 USC 103(a) as allegedly being unpatentable over Guenther in view of case law.

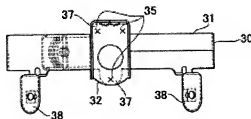
It is respectfully submitted that claim 1 is patentable over the cited references at least because it recites, *inter alia*, "...the spot weld zone is provided on at least one side portion from among both side portions of the band when the band is divided into thirds in the width direction."

Certain embodiments of the present invention are directed to a mounting structure including i) a tank main body which comprises a heat accumulation tank, ii) an elastic member which wraps around substantially the entire periphery of the tank main body, and iii) a mounting

member which wraps around substantially the entire periphery of an outer peripheral surface of the elastic member and which is attached to a receiving member mounted on a vehicle. See paragraph [0007] of the application as published.

Also, a bracket 32 is attached to the band 31 by spot welding, such as in a spot weld zone 35 (which is not located at a portion 36 (FIG. 5) where major surface pressure is generated). If tightening force acts on the band 31 in the circumferential direction, a large surface pressure will be generated at the middle portion when the band 31 is divided into thirds in the width direction. That is, the major surface pressure receiving portion 36 is the middle portion of the band 31 when the band 31 is divided into thirds in the width direction, as shown in FIG. 5. Irregularities and portions where the friction coefficient is discontinuous, which occur at the spot weld zone 35, are undesirable at that portion 36 because they result in uneven surface pressure over the entire area of the band 31. Therefore, the spot weld zone 35 is preferably positioned on a portion other than the major surface pressure receiving portion 36 of the band 31 (for example, as shown at 35 in FIG. 6 below). That is, the spot weld zone 35 is preferably provided on at least one side portion from among both side portions of the band when the band is divided into thirds in the width direction. *According to this structure, it is possible to prevent the surface pressure at the major surface pressure receiving portion 36 from becoming uneven, which enables the heat accumulation tank 1 to be held with greater reliability.*

FIG. 6



In other words, certain embodiments of the present invention connect the flanges by welding so that the flanges of the mounting member and the bracket extend in a tangential direction with respect to the tank. Furthermore, by setting the welds apart from the middle third

of the surrounding band it is ensured that the connection “band - elastic member – tank” is even and smooth along the entire circumference. It is even because the weld spots are remote from the contact surface. Thereby this construction has the advantage that the resulting radial dimensions can be suppressed and become compact which is important in planning a vehicle layout, for example. Moreover, if the welds are apart from the middle third of the band constituting the contact zone a damaging effect is eliminated. There is no local hardening deriving from welds within the contact zone which may cause a leak of the tank in a long-term use.

As an initial matter, with respect to Fariello/Guenther, it is noted that a reference must be analogous art in order to form the basis for an obviousness rejection. M.P.E.P. § 2141.01(a). In order to be analogous, the reference must be reasonably pertinent or within the inventor’s field of endeavor in order to be used in an obviousness rejection. *Id.*

While the present application is directed to mounting structures for heat accumulation tanks of vehicles, Fariello/Guenther are directed to jars and fire extinguishers, respectively. Therefore, it is respectfully submitted that they are not reasonably pertinent or within the Applicant’s field of endeavor. Accordingly, the Applicant respectfully submits they are non-analogous art and may not be used in an obviousness rejection, such as, for example, as alleged in the 35 USC § 103 rejection citing Guenther (or with respect to Fariello in any future obviousness rejection).

Having said that, Fariello and/or Gunther do not describe a spot weld zone provided on at least one side portion from among both side portions of the band when the band is divided into thirds in the width direction. Rather, the alleged bands—area 10 of Fariello and 3 of Guenther (FIGS. 1 and 3—are located along the entire widths of the alleged bands, but not specific spot weld zones as alleged, and as required by the invention of claim 1. Again, claim 1 requires that “the spot weld zone is provided on at least one side portion from among both side portions of the band when the band is divided into thirds in the width direction” as shown in FIG. 6 reproduced herein above. This spot weld zone is simply not taught or suggested in Fariello and/or Guenther.

Thus, lacking any teaching and/or suggestion of such a spot weld zone as claimed, both Fariello/Guenther fail to teach each and every element of the invention of claim 1. It is noted that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union*

*Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Further, it is respectfully submitted that the other cited references do not address the deficiencies of *Fariello/Guenther*.

As discussed in MPEP 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006) (discussing rationale underlying the motivation-suggestion-teaching \*>test< as a guard against using hindsight in an obviousness analysis).

In addition, as discussed in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007), it is necessary to identify the reason why a person of ordinary skill in the art would have been prompted to modify *Fariello/Guenther* in the manner as recited in the invention of claim 1. Obviousness cannot be sustained by mere conclusory statements.

Thus, the Applicant respectfully submits that independent claim 1, as well as its dependent claims, are patentable over the cited references.

Further, with respect to the rejections of the dependent claims, the Applicant respectfully submits that, as discussed in MPEP § 2144, the rationale of a prior legal decision may only be used where the facts are sufficiently similar to those in an application under examination. Therefore, the Applicant respectfully submits that a correlation between the facts of the present application and *In Re Rose* and *In Re Leshin* be set forth for clarification of the record (*In Re Rose* regards lumber packages and *In Re Leshin* plastics for containers). Moreover, as is also stated in MPEP § 2144, if the applicant has demonstrated the criticality of a specific limitation (e.g., the dependent claims recite structure critical for reliable mounting, even application of surface pressure, eliminating leaks, heat retention, etc.), it would not be appropriate to rely solely on case law, as the rationale to support an obviousness rejection.

**IV. Conclusion**

In light of the above discussion, the Applicant respectfully submits that the present application is in all aspects in allowable condition, and earnestly solicits favorable reconsideration and early issuance of a Notice of Allowance. The Examiner is invited to contact the undersigned at (202) 220-4420 to discuss any matter concerning this application. The Office is authorized to charge any fees related to this communication to Deposit Account No. 11-0600.

Respectfully submitted,

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